

REMARKSStatus of Claims

Claims 1-20 are pending in the application. Claim 19 was deemed allowable. Claims 1-5, 8-18 and 20 were rejected. Claims 6 and 7 were objected to. The current claims are drawn to the subject matter of Group I restricted from the parent application 10/044,183. The Examiner requested an election.

Support for Amendments

Applicants respectfully request that claims 1, 2 and 3 be amended. Support for said amendments may be found *inter alia* in various embodiments and examples (including Examples 54-138). Applicants further request that claim 20 be amended. Support for said amendment can be found on page 18, line 15. Applicants respectfully request that claims 17 and 18 be canceled. No new matter has been added in amending said claims. Other aspects of the amendments merely reflect spelling corrections.

The Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 1-5, 8-18 and 20 were rejected under 35 U.S.C. §112, second paragraph, as being "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention." Applicants respectfully traverse. The first basis for the Examiner's rejection was directed at the definition of D'. The Examiner noted that defining D' to be "a bond" could allow R<sup>2</sup> to be double-bonded to Y whereas the structure in claims 1 and 11 show R<sup>2</sup> always being single-bonded to Y. Applicants submit that use of the term "bond" when defining a variable is a well-known convention in the patent literature as a means of assigning a "value of zero" to that variable, *i.e.*, it is simply a means of removing the variable from the formula or creating an "optional variable". Thus where D' is a bond, then D'-D"(R<sup>3</sup>)(R<sup>4</sup>) simply would read D"(R<sup>3</sup>)(R<sup>4</sup>). Even if this were not a known convention in drafting complex chemical claims, the specification supports the same unambiguous meaning and application of D' being a

10/771,766 / CT2662 DIV2

bond. First, not a single example in the specification shows a double bond between  $R^2$  and Y. Second, not a single embodiment in the specification shows a double bond between  $R^2$  and Y. Third, the creation of a double bond between  $R^2$  and Y would result in an improper valency for the carbon atom constituting Y. Fourth, the specification explicitly sets forth that "[t]he description of the invention herein should be construed in congruity with the laws and principals of chemical bonding." See page 28 lines 7 and 8. Thus, even if an incorrect valency were depicted, it should be interpreted as a correct valency. Finally, the Examiner's own observation of the structural depiction of the relationship between  $R^2$  and Y as a single bond in the claims comports with the use of "bond" as a means of representing an "optional variable".

The second basis for the instant §112, second paragraph, rejection was that if D" was C-OH or CH, and said C was bonded to D' while being double bonded to  $R^3$  and  $R^4$ , then said C would appear to have 5 bonds. This concern was specifically addressed in the original claim provisos by not permitting  $R^3$  and  $R^4$  to be attached to CH or C-OH other than by single bonds. See Claim 1 page 323, lines 21-23.

The third basis for the instant §112, second paragraph, rejection concerned a method of treatment claim, i.e., claim 20, which recited use of compounds of the invention for the treatment of various disorders and "yet other disorders requiring neuroprotection" which was believed to be indefinite. It was also asserted that listing depression and anxiety was indefinite because the disorders "have conflicting symptoms". Applicants have deleted the phrase "yet other disorders requiring neuroprotection" in order to remove that as a grounds for rejection and expedite prosecution. Instead amended claim 20 is directed to depression and anxiety. Applicants respectfully submit that simply because two indications appear to have contradictory symptoms in no way renders such a claim indefinite. A potential infringer would have no uncertainty in determining whether a compound of the present invention used for depression or anxiety would infringe amended claim 20. Therefore, Applicants respectfully request the Examiner to withdraw the instant §112, second paragraph, rejection.

The Rejection Under 35 U.S.C. §112, First Paragraph

Claim 20 was further rejected for lack of enablement under §112, first paragraph, as being "unduly broad" and listing uses having "conflicting symptoms". Applicants have amended claim 20 to be directed to anxiety and depression. The Examiner maintains that anxiety is allowable but not together with depression since it is a "conflicting" symptom. Applicants respectfully traverse said rejection. Applicants have cited several references supporting the use of CRF antagonists for *both* anxiety and depression. *See* page 1 lines 30-32 and page 2, lines 1-7. Thus Applicants have satisfied §112, first paragraph, by demonstrating that the "state of the art" (according to *In re Wands*) supported *both* anxiety and depression as credible uses for CRF antagonists. Applicants therefore respectfully request that the instant §112, first paragraph, rejection be withdrawn.

The Rejection Under 35 U.S.C. §102(b)

Claims 1, 2, 9, 10 and 14 were rejected under §102(b) in view of *Satow et al.*, (EP 970,958 A1, of record). Applicants have amended claim 1 such that a carbonyl cannot be present in the pyrimidinyl portion of the ring system. Thus, none of the examples referred to by the Examiner in *Satow et al.*, read on amended claim 1. Claims 2, 9, 10 and 14 depend from amended claim 1 and therefore are not anticipated by *Satow et al.* Thus, Applicants respectfully request the instant §102(b) rejection to be withdrawn.

Claim Objections

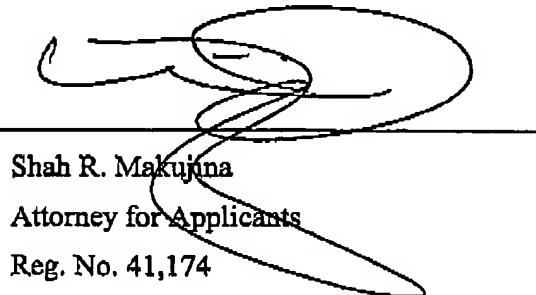
Claims 6 and 7 were objected to as depending from claim 1, a rejected claim but were considered allowable if rewritten in independent form. In light of the amendments to claim 1, Applicants believe claim 1 is in allowable condition and thus claims 6 and 7 can be suitably left in dependent form.

10/771,766 / CT2662 DIV2

In light of the amendments and remarks herein, Applicants respectfully request the Examiner to enter said amendments and respectfully submit that the application is in condition for allowance. Applicants reserve the right to file divisional application(s) on non-elected subject matter. The Commissioner is authorized to withdraw any necessary fees from Deposit Account 19-3880.

Respectfully submitted,

Dated: January 6, 2006

  
\_\_\_\_\_  
Shah R. Makujina  
Attorney for Applicants  
Reg. No. 41,174

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
Phone: (203) 677-7268